

rejected under the judicially created doctrine of double patenting over claims 22-28 of U.S. Patent No. 5,958,422.

Applicants believe that the following remarks traverse the Examiner's rejection of the claims. These remarks are presented in the same order as they appear above.

A. The Claims are not Anticipated

The Examiner has rejected Claims 1, 2, 7-10, 15 and 16 under 35 U.S.C. 102(e) as anticipated by U.S. Patent 5,316,931. The Applicants respectfully disagree. "[T]he rule is that the burden of persuasion is on the PTO to show why the applicant is not entitled to a patent." *In re Epstein*, 31 USPQ2d 1817, 1825 (Fed. Cir. 1994) (Plager, J. joined by Cowen, J., concurring.)(citing to *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) (Plager, J., concurring); *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057(1968)). "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The present application has a priority date of April 16, 1991. The '931 patent has a filing date of July 31, 1992. Importantly, the July 31, 1992 filing was a *continuation-in-part*, which indicates that new matter was added. The Examiner has the burden in the first instance to show that the disclosure (now used as a basis for rejection) was in an earlier application in the lineage. In an attempt to satisfy this burden, the Examiner presents an 88-page document entitled "Non-Nuclear Chromosomal Transformation" (apparently dated stamped February 17, 1989) and argues that this document is "US Application No. 07/600,244" and discloses "the insertion of a foreign peptide in the coat protein to produce a recombinant plant virus." (Office Action, page 5). By contrast, the document is identified by the Examiner on form PTO-892 as "US Appl. No. 07/600,881." However, the face page of US Patent 5,316,931 does not indicate the latter application serial number in the lineage. Rather, the '931 Patent indicates that Ser. No. 310,881 was filed on February 17, 1989 and that Ser. No. 600,244 is a

continuation. Thus, it would appear that the "600,881" on PTO-892 is a typographical error and should read "310,881." The Examiner is respectfully requested to confirm that i) the 88-page document is, in fact, the 310,881 specification, and ii) the '931 Patent face page is correct in that the 600,244 application is a continuation of 310,881 (and not a continuation in part).

Even assuming the 88-page document supplied by the Examiner was filed February 17, 1989 as Ser. No. 310,881, the Examiner has clearly not met the requisite burden necessary to make a 102 rejection. The attached Declaration of Dr. Lada Rasochova makes clear that the Examiner has misinterpreted the science in the 88-page document. The examples in the 88-page document do not teach what the Examiner argues they teach. Even when additional examples are considered, the alleged teachings are not found. Therefore, the '881 specification is not relevant, making the '931 Patent also not relevant.

B. The Claims are not Obvious

The Examiner has rejected Claims 1-16 under 35 U.S.C. 103 as being obvious over a combination of U.S. Patent 5,316,931, the '881 specification, and the '976 patent. The MPEP states that in order for a reference to be prior art under 35 U.S.C. 103 it must meet the same criteria as 35 U.S.C. 102 prior art. MPEP § 2141.01. In other words, publications that are not prior art under 35 U.S.C. 102 are not prior art under 35 U.S.C. 103. As demonstrated in the previous section, the Examiner has not established that the '931 patent is entitled to a priority date such that it qualifies as prior art. Moreover, the Examiner cannot merely make an assumption in this regard. *See In re Rijckaert*, 28 USPQ2d 1955 at 1956 (Fed. Cir. 1993)("[T]he examiner's assumptions do not constitute the disclosure of the prior art."); *See id.* at 1957 ("[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears.").

Furthermore, the '881 specification - while perhaps *prior* - does not supply the teachings on which the Examiner relies. Therefore, even if (improperly)¹ combined with the '976 patent, the elements of the pending claims cannot be found.

¹ Applicants do not accept that the combination can be legitimately made in the first instance.

C. Double Patenting

The Examiner has rejected Claims 9-16 under the judicially created doctrine of double patenting over claims 1-9 of U.S. Patent 5,874,087 stating that the claims are not patentably distinct over the claims of the '087. The Applicants respectfully disagree.

Nonetheless, provided Applicants' claims are otherwise found allowable, Applicants may split out Claims 9-16 into a separate application with the required Terminal Disclaimer. This would permit Claims 1-8 to issue. The Examiner is requested to call the undersigned prior to another Office Action in order to discuss this procedure.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that these grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.252.3353.

Dated: December 27, 2002



Peter G. Carroll
Registration No. 32,837

MEDLEN & CARROLL, LLP
220 Montgomery Street, Suite 2200
San Francisco, California 94104